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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,157	02/25/2004	John G. Carman	15740.006	8150

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EXAMINER

ROBINSON, KEITH O NEAL

ART UNIT	PAPER NUMBER
1638	

DATE MAILED: 09/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/785,157

Applicant(s)

CARMAN, JOHN G.

Examiner

Keith O. Robinson, Ph.D.

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-26 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-12, drawn to a method of producing an apomictic plant from sexual plants comprising selecting a first and second sexual plant from an angiospermous plant species, genus or family, wherein the initiation time of embryo sac formation in the first plant occurs at about the same time as or before megasporogenesis in the second plant relative to the developmental maturity of the nongametophytic ovule and ovary tissues, classified in class 800, subclass 260, for example.
  - II. Claims 13-14 and 25-26, drawn to an apomictic plants, classified in class 800, subclass 295, for example.
  - III. Claims 15-24, drawn to a method of producing an apomictic plant from sexual plants comprising screening plants within an angiospermous plant species, genus or family for differences in the timing of initiation of megasporogenesis and embryo sac formation relative to the developmental maturity of nongametophytic ovule and ovary tissues among the plants and selecting a first and second sexual plant from an angiospermous plant species, genus or family, wherein the initiation time of embryo sac formation in the first plant occurs at about the same time as or before megasporogenesis in the second plant relative to the

developmental maturity of the nongametophytic ovule and ovary tissues, classified in class 800, subclass 266, for example.

Applicant is advised that the reply to this requirement to be complete within one month (not less than 30 days) must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process such as selection of apomictic plants from a selfed progeny of a heterozygous sexual clone, for example.

Furthermore, searching the invention of group I together with the invention of group II would impose a serious search burden. In the instant case, prior art searches of a method of producing an apomictic plant from sexual plants comprising selecting a first and second sexual plant from an angiospermous plant species, genus or family, wherein the initiation time of embryo sac formation in the first plant occurs at about the same time as or before megasporogenesis in the second plant relative to the developmental maturity of the nongametophytic ovule and ovary tissues are not coextensive with prior art searches of an apomictic plant. Search of each of these inventions would require different key word searches of each compound and of each

distinctive step of the method using divergent patent and non-patent literature databases. The different searches would then require subsequent in-depth analysis of the unrelated prior art literature, placing a serious burden on the Office in terms of both search and examination. As such, it would be burdensome to perform examination of inventions I and II together.

3. Inventions I and III are directed to related processes. The related inventions are distinct if the (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the inventions as claimed have a materially different mode of operation in that the invention of group I does not require the screening step used in the invention of group III. Furthermore, the inventions as claimed do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.

In addition, searching the invention of group I together with the invention of group III would impose a serious search burden. In the instant case, prior art searches of a method of producing an apomictic plant from sexual plants comprising selecting a first and second sexual plant from an angiospermous plant species, genus or family, wherein the initiation time of embryo sac formation in the first plant occurs at about the same time as or before megasporogenesis in the second plant relative to the developmental maturity of the nongametophytic ovule and ovary tissues are not coextensive with prior art searches of a method of producing an apomictic plant from

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sexual plants comprising screening plants within an angiospermous plant species, genus or family for differences in the timing of initiation of megasporogenesis and embryo sac formation relative to the developmental maturity of nongametophytic ovule and ovary tissues among the plants and selecting a first and second sexual plant from an angiospermous plant species, genus or family, wherein the initiation time of embryo sac formation in the first plant occurs at about the same time as or before megasporogenesis in the second plant relative to the developmental maturity of the nongametophytic ovule and ovary tissues. Search of each of these inventions would require different key word searches of each compound and of each distinctive step of the method using divergent patent and non-patent literature databases. The different searches would then require subsequent in-depth analysis of the unrelated prior art literature, placing a serious burden on the Office in terms of both search and examination. As such, it would be burdensome to perform examination of inventions I and III together.

4. Inventions II and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process such as selection of apomictic plants from a selfed progeny of a heterozygous sexual clone, for example.

Furthermore, searching the invention of group II together with the invention of

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group III would impose a serious search burden. In the instant case, prior art searches of an apomictic plant are not coextensive with prior art searches of a method of producing an apomictic plant from sexual plants comprising screening plants within an angiospermous plant species, genus or family for differences in the timing of initiation of megasporogenesis and embryo sac formation relative to the developmental maturity of nongametophytic ovule and ovary tissues among the plants and selecting a first and second sexual plant from an angiospermous plant species, genus or family, wherein the initiation time of embryo sac formation in the first plant occurs at about the same time as or before megasporogenesis in the second plant relative to the developmental maturity of the nongametophytic ovule and ovary tissues. Search of each of these inventions would require different key word searches of each compound and of each distinctive step of the method using divergent patent and non-patent literature databases. The different searches would then require subsequent in-depth analysis of the unrelated prior art literature, placing a serious burden on the Office in terms of both search and examination. As such, it would be burdensome to perform examination of inventions II and III together.

5. Because the inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, classification, and fields of search, restriction for examination purposes as indicated is proper.

6. The Examiner has required restriction between product and process claims. Where Applicant elects claims directed to the product, and a product claim is subsequently found

allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent



issues. See MPEP § 804.01.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith O. Robinson, Ph.D. whose telephone number is 571-272-2918. The examiner can normally be reached on Monday - Friday 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached on (571) 272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

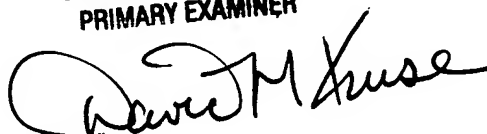
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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Keith O. Robinson, Ph.D.

September 5, 2006

DAVID H. KRUSE, PH.D.  
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read "David H. Kruse", written in a cursive style.